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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,951	02/10/2004	Matthias Riepenhoff	71294	1657

7590 08/27/2004
McGLEW AND TUTTLE
John James McGlew
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Scarborough, NY 10510-0827

EXAMINER

FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,951

Applicant(s)

RIEPENHOFF ET AL.

Examiner

Stephen R Funk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/109,476.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/20/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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The disclosure is objected to because of the following informalities: On page 22 line 11, page 23 line 1, and page 24 line 11 “inking roll 39” should be --impression cylinder 39--. Appropriate correction is required.

Claims 4, 12, and 13 are objected to because of the following informalities:

In claim 4 line 1 “said illustrated surface” lacks proper antecedent basis.

In claim 12 lines 1 - 2 and claim 13 lines 2 - 3 “the radiation sources of said imaging means” lacks proper antecedent basis.

Appropriate correction is required.

Claims 2, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 2 recites the broad recitation “at least 60%”, and the claim also recites “preferably at least 80%”, which is the narrower statement of the range/limitation.

In claim 9 line 4 and claim 10 line 4 “preferably” renders the claims indefinite for the same reasons above.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by D'Heureuse et al. (US 6,318,264).

D'Heureuse et al. teach providing a photocatalytically and thermally modifiable printing form that can be brought into a hydrophilic state by irradiation with UV light (column 4 lines 35 - 53, column 8 line 66 - column 9 line 12) and into a lipophilic state by heating (column 4 lines 5 - 8, column 8 lines 38 - 44), erasing a printing style by irradiating the entire surface with UV light (column 8 line 66 - column 9 line 12), and feeding water to the surface during the irradiation (column 9 lines 1 - 6).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Heureuse et al. D'Heureuse et al. do not teach the specific humidity at the surface during the irradiation. However, it would have been obvious to one of ordinary skill in the art through routine experimentation to arrive at the recited humidity during the irradiation so as to optimize the hydrophilizing of the surface.

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Claims 2, 3, 5, and 8 - 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Heureuse et al. in view of Pers (US 5,365,847).

With respect to claims 2 and 5, D'Heureuse et al. do not specifically teach maintaining the surface of the printing form during the irradiation at a preset humidity. However, it would have been obvious to one of ordinary skill in the art that a particular humidity during the irradiation would optimize hydrophilizing the surface of the printing form. Pers teaches a humidifying unit for maintaining an optimum humidity. See column 5 lines 17 - 30 of Pers, for example. It would have been obvious to one of ordinary skill in the art to provide the method and apparatus of D'Heureuse et al. with a humidifying unit in view of Pers so as to optimize the hydrophilizing of the surface.

With respect to claim 3 Pers teaches also controlling the temperature. It is well known that temperature affects humidity. It would have been obvious to one of ordinary skill in the art to provide the method of D'Heureuse et al. with a preset temperature in view of Pers so as to more easily control the humidity.

With respect to claims 8 - 10 note the radiation source (14) of D'Heureuse et al. With respect to claim 9 it would have been obvious to one of ordinary skill in the art to maintain the radiation source of D'Heureuse et al. at a peak wavelength of 387 nm so as to only emit effective UV radiation to the printing form surface. With respect to claim 10 see column 1 lines 63 - 65 and the sentence bridging columns 8 and 9 of D'Heureuse et al.

With respect to claims 11 - 13 see column 4 lines 5 - 8 and column 8 lines 38 - 44 of D'Heureuse et al., for example. With respect to claim 13 it would have been obvious

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to one of ordinary skill in the art to arrange the LED row of D'Heureuse et al. along the axis of the form cylinder so as to quickly image a rotating printing form.

Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There is no motivation to provide the apparatus of D'Heureuse et al. with an encapsulation for the printing form and a plurality of cylinders of the printing unit since D'Heureuse et al. teach only providing humidified area to a small portion of the form cylinder.

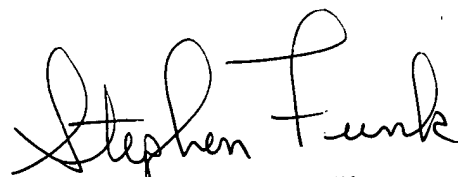
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the entire document of Gutfleisch et al. ('209), column 2 lines 35 - 43 of Nussel et al. ('970), and column 8 line 17+ of Palmatier ('848).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

SRF
August 26, 2004



STEPHEN R. FUNK
PRIMARY EXAMINER